

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed August 12, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Drawings

In reviewing the instant patent application, Applicant discovered a mistake in Figure 5. In response to this discovery, Applicant has amended Figure 5. A clean copy of Figure 5 is included with this Response. Applicant submits that no new matter has been added.

II. Claim Rejections - 35 U.S.C. § 102(e)

A. Rejection of Claims 1-2, 6, and 9-10

Claims 1-2, 6, and 9-10 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Berger (U.S. Pat. No. 6,112,986). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

As is indicated above, independent claims 1 and 9 have been amended through this Response. In view of this fact, Applicant believes that the rejection is moot as

having been drawn against the claims in a previous form. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

B. Rejection of Claims 14 and 19-20

Claims 14 and 19-20 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Chan et al. (“Chan,” U.S. Pat. No. 6,378,070). Applicant respectfully traverses this rejection.

As is indicated above, independent claims 1 and 9 have been amended through this Response. In view of this fact, Applicant believes that the rejection is moot as having been drawn against the claims in a previous form. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

III. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 3 and 7-8

Claims 3 and 7-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Berger in view of Takagawa, et al. (“Takagawa,” U.S. Pat. No. 5,987,612). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be a prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied

reference. It is respectfully asserted that no such case has been made in the outstanding Office Action. Applicant discusses the applied references and Applicant's claims in the following.

Applicant's independent claims 1 and 9, as amended, provide as follows (emphasis added):

1. A method for completing forms, comprising:
reading a user data card to determine a network location at which user information to be added to a form is stored;
retrieving the user information from the network location;
configuring the user information for merging with the form;
merging the user information into the form by populating form data fields with pieces of the user information; and
printing a hard copy form that contains at least a portion of the user information.

Berger does not teach retrieving user information from a network location. For this reason, Takagawa is relied upon to teach such retrieval. In the Office Action, it is stated:

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Berger and Takagawa because both inventions use card(s) and reader(s) to automatically convey user information to a system, preventing the user from having to remember the information and then manually entering the information with the potential of making mistakes thereby wasting time.

As an initial matter, Applicant respectfully submits that a person of ordinary skill in the art would not be motivated to make such a combination in view of the teaching of

Berger and Takagawa. In particular, such a person would be motivated *against* such a combination, and modification of the Berger system, because of Berger's own teachings contained in the Berger reference. In his disclosure, Berger actually touts the advantages of his disclosed "MEDICOMPUCARD". For instance, in column 6, lines 39-45, Berger states (emphasis added):

A common type of 2-D bar-code is known as a PDF 417 bar-code and is capable of reliably storing several kilobytes of information. A kilobyte is 1024 bytes, or for our purposes here, characters. The ability to encode the entire Gettysburg Address in a single 2-D label has been demonstrated. This capacity is much greater than the common magnetic strip media found on the back of credit cards.

From the above-provided excerpt, it is clear that Berger teaches and recommends use of a card that has enough storage capacity such that all relevant data to be provided can be contained on the card and, therefore, teaches and recommends storing all relevant data on the card. From these teachings, a person having ordinary skill in the art would not be inclined to only store "location information" as recited in Applicant's claims which merely identifies the location of user's information. Indeed, given the Berger's card can contain all of the relevant data, persons having ordinary skill in the art would be motivated against such a modification given that that modification would require the extra steps and associated hardware necessary to retrieve the user information from a network location. In other words, Berger can be said to teach away from such a modification. As is well established in the law, "[t]here is no suggestion to combine . . . if a reference teaches away from its combination with another source . . . A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or

would be led in a direction divergent from the path that was taken by the applicant . . .” *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

In view of the above, Applicant submits that a person having ordinary skill in the art would not have considered it obvious in view of Berger and Takagawa to read “a user data card to determine a network location at which user information to be added to a form is stored” and retrieve “the user information from the network location” as is provided in independent claim 1. Accordingly, Applicant submits that those claims are allowable over Berger/Takagawa. Given that claims 3 and 7-8 depend from claim 1 and incorporate all of the limitations of claim 1, those claims are also allowable over Berger/Takagawa for at least the same reasons.

B. Rejection of Claims 4-5 and 11-12

Claims 4-5 and 11-12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Berger in view of Harper, et al. (“Harper,” U.S. Pat. No. 6,651,060). Applicant respectfully traverses this rejection.

As identified above in reference to independent claim 1, Berger teaches away from retrieving user information from a network location and instead only teaches obtaining all user information directly from data stored on a card. In view of these teachings, a person having ordinary skill in the art would not be motivated by the Harper reference to modify the Berger system to retrieve user information from a network location as provided in claim 1. Given that claims 4 and 5 depend from claim 1 and incorporate all of its limitations, claims 4 and 5 are allowable over Berger/Harper for at least the same reasons that claim 1 is allowable over Berger/Harper.

With regard to independent claim 9, a person having ordinary skill in the art would not be motivated to provide “means for retrieving user information from a network location identified in the location information” for similar reasons. Accordingly, claims 11 and 12, which depend from claim 9 and incorporate all its limitations, are likewise allowable over Berger/Harper.

C. Rejection of Claim 15

Claim 15 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Chan in view of Takagawa. Applicant respectfully traverses this rejection.

Applicant notes that because the Chan reference issued after Applicant’s filing, the Chan reference can only qualify as prior art as to Applicant’s claims under 35 U.S.C. § 102(e). The Chan reference, however, is not “by another” under 35 U.S.C. § 102(e) because the subject matter of the Chan reference and Applicant’s claimed inventions were owned by the same legal entity (i.e., the Hewlett-Packard Company) or were subject to an obligation of assignment to that the legal entity when the inventions were made. In such a case, the cited reference may not be used against the Applicant’s claims under 35 U.S.C. § 103. See 35 U.S.C. § 103(c) (“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”).

In view of the above, Applicant respectfully submits that the rejection is improper and requests that the rejection be withdrawn.

D. Rejection of Claims 16-18

Claims 16-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Chan. Applicant respectfully traverses this rejection.

As noted above in relation to the rejection of claim 15, the Chan reference is not properly citable against Applicant's claims. Applicant therefore requests that the rejection be withdrawn.

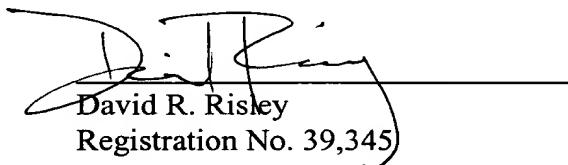
IV. Canceled Claims

As identified above, claims 4, 6, 16 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

9-30-04

Mary Meegan
Signature